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09/519,998	22-Oct-01	D. SCOTT WILBUR, ET AL	033700 WC 003

Title: TRIFUNCTIONAL REAGENT FOR CONJUGATION TO  
A BIOMOLECULE

Art Unit	Paper Number
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Please find attached a communication from the Examiner regarding the  
Petition for Retroactive License under 37 CFR 5.25.

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In re: Wilbur et al. :DECISION ON REQUEST  
Filing date: October 9, 2001 :UNDER 37 CFR 5.25  
Serial No.: 09/519,998  
Docket No.: 033700 WC 003

Title: TRIFUNCTIONAL REAGENT FOR CONJUGATION TO A BIOMOLECULE

This is a decision on the petition filed October 9, 2001 for retroactive foreign filing license.

Decision: Denied

37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
  - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
  - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
  - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee ( § 1.17(h)).

The petition is Denied at this time in that the petition is defective since the requirements set forth in 37 C.F.R. 5.25(a)(3)(ii, iii) have not been met.

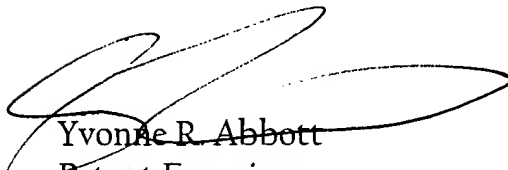
As to the question of diligence, there appears to be an unexplained extensive lapse

of time between when the error was discovered (5/01) and when the petition was filed (10/01). Additionally, since a petition was filed on 8/27/01 for co-pending application 09/750,280, a more detailed explanation is necessary as to why a petition for the instant application was not filed concurrently since both applications involve the same inventors.

As to the requirement of 37 C.F.R. 5.25(a)(3)(iii), the petition does not include a verified statement by one (Dr. Wilbur and Mr. Henriksson) who actually filed the patent applications, or who had personal knowledge of the acts regarding filing in a foreign country accompanied by copies of necessary supporting documents. Mr. Weilacher is not considered to either have filed the application or have personal knowledge of the acts regarding filing, and therefore, his statement is inadequate to satisfy the requirements of 37 C.F.R. 5.25. Additionally, the Exhibit A (letter from Dr. Wilbur to Mr. Henriksson) was not included with the petition as stated in the petition.

Thus, in the absence of a verified statement including an explanation or showing that the license was diligently sought, and that the foreign application was filed through error without deceptive intent, the provisions of 37 CFR 5.25 have not been met.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is DENIED, and in the absence of any response within 60 days of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).



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